

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

OCT 30 2001

Ex parte ALBERT J. SILVERA

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2001-1445
Application No. 09/268,412

HEARD: October 9, 2001

Before CALVERT, ABRAMS, and BAHR, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4 to 9 and 11 to 19, all the claims remaining in the application.¹

The claims on appeal are drawn to a method of decorating a shoe (claims 1, 2 and 4 to 9) and a decorated shoe (claims 11 to 19). Independent claims 1 and 11 read as follows:

¹ After the final rejection, claims 10 and 20 were canceled, and claims 1 and 11 were amended (amendment filed September 14, 2000).

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1. A method for decorating a shoe, comprising:

wetting a stick-on tattoo; and

applying the stick-on tattoo to a smooth portion of an outer surface of the shoe,

wherein the stick-on tattoo does not include separate adhesive material, and wherein the stick-on tattoo is applied to the shoe without using separate adhesive material.

11. A decorated shoe, comprising:

a shoe having an outer surface which includes a smooth portion; and

a stick-on tattoo attached to the smooth portion of the outer surface of the shoe,

wherein the stick-on tattoo does not include separate adhesive material and adheres to the shoe without use of separate adhesive material.

The references applied in the final rejection are:

Kellin et al. (Kellin)	5,136,726	Aug. 11, 1992
Vidinic	5,290,043	Mar. 1, 1994
Lehmann et al. (Lehmann)	5,421,765	Jun. 6, 1995
Penataro (French patent)	764,103	May 15, 1934 ²

The appealed claims stand finally rejected under 35 U.S.C.
§ 103(a) on the following grounds:

(1) Claims 1, 2, 5, 7 to 9 and 11, unpatentable over Lehmann in view of Vidinic;

² A translation of this reference, prepared for the PTO, is forwarded to appellant herewith.

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(2) Claims 1, 2, 4 to 9 and 11, unpatentable over Lehmann in view of Kellin;

(3) Claims 12 to 19, unpatentable over Penataro in view of Lehmann.³

Rejection (1)

As it applies to claims 1 and 11, the basis of this rejection, as stated on pages 2 and 3 of the final rejection, is:

Lehmann '765 teaches substantially all the limitations of the claims such as stimulated tattoos/stickers **32** comprising a front image surface **32a** which carries the visible design of the stimulated tattoos/stickers, and an adhesive backing means **32b** adapted to be removably secured to different parts of either or both a toy element means **12** and or a child. The back of the stimulated tattoos/stickers are moistened and then placed on and/or removed from the hair or the surface or clothing of the toy element means **12** or the child. Lehmann '756 does not appear to specifically teach providing stimulated tattoos/stickers on different parts of the shoe. Providing stimulated tattoos/stickers on different parts of the shoe, is so old and conventional as to hardly require citation of a reference, but Vidinic '043 is provided merely as an example of this common practice. Therefore, it would have been obvious to one having ordinary skill in the art and in view of Vidinic '043 to provide stimulated tattoos/stickers on shoes to decorate them as one pleases.

Appellant argues at page 7 of the brief that Lehmann does not meet the requirements of claims 1 and 11 that the stick-on tattoo

³ Since claims 12 to 19 depend from claim 11, it is not clear why claim 11 was not included in this rejection.

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"does not include separate adhesive material" and is applied or adheres to the shoe without using "separate adhesive material." The examiner, on the other hand, asserts that the stick-on tattoos disclosed by Lehmann "appear to be the same as the tattoos used in the present invention, despite Lehmann's characterization to the contrary," and "do not require a separate adhesive to adhere to [a] surface and are believed to adhere inherently when the print gets wet" (answer, page 8).

In construing the meaning of language in a claim,

the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also, In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969) (claims will be given their broadest reasonable interpretation consistent with the specification). In the present case, in construing the claim expression "the stick-on tattoo does not include separate adhesive material," we note that at page 6 of the specification appellant discloses that the tattoo (decal) 102 is preferably "formed as a film-like material (often referred to as tacky

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material)" (lines 28 and 29), and at page 7, lines 20 and 21, that "Because the stick-on tattoo is formed from a film-like material, it can adhere to surfaces without the need for a separate adhesive." Interpreting claims 1 and 11 in light of this description, we do not consider that the claimed expression "the stick-on tattoo does not include separate adhesive material" can be properly construed to include the tattoo 32 disclosed by Lehmann, since the Lehmann tattoo has not only a front image surface 32a, but also a separate adhesive backing layer 32b. Accordingly, even if the Lehmann tattoo were applied to a shoe, as proposed by the examiner, all the limitations of claims 1 and 11 would not be met.

In the answer, however, the examiner goes further, amplifying the basis of the rejection with the statement that (page 4):

if there is any doubt that [the Lehmann] tattoos are different [from the claimed tattoos], there is nothing unobvious about using any of the well known tattoos such as those in the instant specification page 7, lines 1-3, instead of the simulated tattoos of Lehmann removably secured to a body or article of footwear.

The part of the specification referred to by the examiner reads:

One present representative brand of stick-on tattoos usable in practicing the present invention is sold under the trademark Skin Wear® by Johnson & Mayer, Inc., of Hackensack, New Jersey.

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We do not consider that, even considering this disclosure along with the Lehmann and Vidinic references, a prima facie case of obviousness has been established. While this disclosure does show that tattoos of the type claimed were a known commodity at the time the application was filed, they were intended to be applied to the skin (see specification page 6, lines 27 to 32).

In our view, the surface of the typical shoe, such as that disclosed by Vidinic, is so different from a person's skin that one of ordinary skill would not have found it obvious to apply one of these known skin tattoos to a shoe.

The rejection therefore will not be sustained as to claims 1 and 11, nor as to claims 2, 5 and 7 to 9, which depend on claim 1.

Rejection (2)

The examiner's rationale in making this rejection is essentially the same as for rejection (1), and is equally unpersuasive. The Kellin reference does not overcome the deficiencies discussed above. Consequently, rejection (2) will not be sustained.

Rejection (3)

This rejection will not be sustained. Parent claim 11 requires a stick-on tattoo which "does not include separate

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material" and "adheres to the shoe without use of separate adhesive material." As discussed above in connection with rejection (1), the tattoos disclosed by Lehmann do not meet these limitations. Penataro's disclosure is likewise deficient, since strip A is simply disclosed as being applied to the shoe "by an appropriate method so as to be fixed or glued to the edge of the sole or to adhere to it . . . such that it is impossible to detach it from the shoe "(translation, page 2, lines 1 to 4). Thus, since the combination of Penataro and Lehmann would not meet parent claim 11, the rejection of dependent claims 12 to 19 cannot stand.

We further note that as to claims 12 to 14, which require that the shoe have a recessed portion, no such recessed portion is disclosed by Penataro, the strip A being applied to the edge of the sole.

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Conclusion

The examiner's decision to reject claims 1, 2, 4 to 9 and 11 to 19 is reversed.

REVERSED

Tom A. Cahner

IAN A. CALVERT
Administrative Patent Judge



NEAL E. ABRAMS
Administrative Patent Judge

Jim D. Zahn

JENNIFER D. BAHR
Administrative Patent Judge

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